



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/382,421	08/24/1999	JEFFRY JOVAN PHILYAW	PHLY-24.740	5215
25883	7590	04/27/2005	EXAMINER	
HOWISON & ARNOTT, L.L.P P.O. BOX 741715 DALLAS, TX 75374-1715			LUU, LE HIEN	
			ART UNIT	PAPER NUMBER
			2141	

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/382,421

Applicant(s)

PHILYAW ET AL.

Examiner

Le H Luu

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

1. Claims 1-9 are presented for examination.
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. Claims 1-9 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Perkowski patent no. 6,064,979, in view of Wilz, Sr. et al. (Wilz) patent no. 6,394,354.
4. As to claim 1, Perkowski teaches the invention substantially as claimed, including a visual indicia for facilitating computer based access of a network by consumer, comprising:

a machine readable code disposed on a surface of a product and having encoded therein information as to the product, which product is provided by the product manufacturer, and which machine readable code is physically associated with the product itself, which machine readable code has no routing information contained therein to allow a user to access any location on a network, and which machine readable code has a relationship to the product or service unrelated to routing information (col. 10 lines 14-33; UPC or UPN has relationship to a product or service but has no routing information);

the machine readable code being a part of a relational database that associates the machine readable code with a defined location on the network and the relational database associated with a routing system that facilitates connection to the remote location on the network (col. 6 line 26-56); and

a visual indicia having no apparent relationship to the machine readable code or to the defined location disposed on said surface in a predetermined proximate visual orientation to said machine readable code, such that the machine readable code and the visual indicia together form a defined composite visual appearance (Perkowski, col. 4 lines 5-23; col. 20 line 9-14; col. 21 line 52 - col. 22 line 19; trademark symbol or logo or company name is printed on service or product with bar code), indicative of a relationship between said machine readable code and the presence of a location on a network that will use the routing system for connection to the remote location and that such location on the network can be accessed by a computer having an appropriate input device (Perkowski, bar code reader or scanner) for reading said machine readable code, such that reading of said machine readable code by said input device will cause the routing system to connect the computer to the remote location (col. 10 line 14 – col. 11 line 16; col. 15 lines 9-43).

However, Perkowski does not explicitly teach the visual indicia associated with the routing system and indicates that scanning of the machine readable code will cause computer based access of the network.

Wilz teaches each URL encoded bar code symbol (machine readable code) is printed above each Web-site URL (visual indicia) which indicates that scanning of the

Art Unit: 2141

URL encoded bar code3 symbol will cause computer based access the Web-site URL (col. 2 lines 49 - col. 3 line 12; col. 7 lines 20-40; col. 16 line 61 - col. 17 line 18).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Perkowski and Wilz to provide a visual indicia on the same surface as the bar code or machine readable code to indicate that by scanning of the machine readable code will cause computer based access of the network because it would indicate to users the URL that contains additional information.

5. As to claim 2-6, Wilz teaches said visual indicia is not machine readable (col. 16 line 61 - col. 17 line 18).

6. As to claims 3-6, Perkowski teaches said machine readable code represents a product, machine readable code is disposed on a product, machine readable code is closed association with said product, and machine readable code is a UPN (col. 4 lines 14-22; col. 12 line 65 – col. 13 line 9).

7. As to claim 7, Perkowski and Wilz teach the invention substantially as claimed as discussed above; however, Perkowski and Wilz do not explicitly teach said machine readable code is an ISBN.

Official Notice is taken that ISBN is well known.

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the well known teaching with Perkowski's system to

use ISBN as one of machine readable code because it would allow user to get more information related to a publication.

8. As to claim 8, Perkowski teaches said machine readable code is an EAN (col. 6 lines 26-46; EPC reads on EAN which is European Article Numbering).

9. As to claim 9, Perkowski teaches said machine readable device is a scanner (col. 19 lines 38-40).

10. In the remarks, applicant argued in substance that

(A) Prior art does not teach the visual indicia on the product surface in a predetermined proximate visual orientation to the machine readable code.

As to point (A), the visual indicia that applicant claims is a logo 2504 (applicant's specification page 50 lines 4-16). Perkowski teaches applying UPC label or bar code (machine readable code) to external packaging of products. Perkowski also teaches to combine the use of UPC label, and company names or trademarks (visual indicia) to request product information. UPC label and trademark are inherently adjacent to each other on external packaging of products. Therefore, Perkowski inherently teaches the visual indicia on the product surface in a predetermined proximate visual orientation to the machine readable code (Perkowski, col. 4 lines 5-23; col. 10 line 14 – col. 11 line 16; col. 15 lines 9-43; col. 20 line 9-14; col. 21 line 52 - col. 22 line 19).

Art Unit: 2141

(B) Prior art does not teach the visual indicia that is indicative of a scanning operation but not any particular address or location that will then indicate that a bar code that is related to the product and not to a destination can be scanned, and that scanning operation will route it to a destination, which destination is not associated with the bar code.

As to point (B), Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process."). Therefore, limitations that are argued by applicant but are not in claimed language are not being considered by Examiner.

11. Applicant's arguments filed on 12/03/04 have been fully considered but they are not deemed to be persuasive.

Art Unit: 2141

12. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Le H Luu whose telephone number is 571-272-3884.

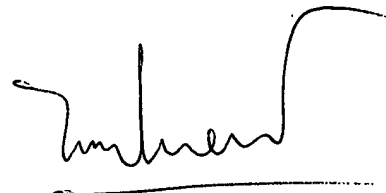
The examiner can normally be reached on 7:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/382,421
Art Unit: 2141

Page 8

A handwritten signature in black ink, appearing to read 'Le Hien Luu', written over a horizontal line.

LE HIEN LUU
PRIMARY EXAMINER

April 19, 2004